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Hayes

September 30, 2021

Cancellation No. 92072469

Disappearing Ink, LLC

v.

Disappearing, Inc.

Before Wellington, Larkin, and Dunn,
Administrative Trademark Judges.

By the Board:

This case comes up for consideration of Respondent's motion, filed August 27, 2020, for summary judgment on its first affirmative defense asserting Petitioner's likelihood of confusion claim is time-barred under 15 U.S.C. § 1064.[1] The motion is fully briefed.[2]

We have carefully considered the parties' briefs and evidence but addresses the record only to the extent necessary to support our analysis and findings, and do not

[1] 18 TTABVUE 1. Citations to the record or briefs in this order include citations to the publicly available documents on TTABVUE, the Board's electronic docketing system. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry.

[2] The Board regrets the delay in deciding this motion.

repeat or address all of the parties' arguments. *See Guess? IP Holder LP v. Knowluxe LLC,* 116 USPQ2d 2018, 2019 (TTAB 2015).

I. Background

On April 22, 2014, Registration No. 4518685 issued to Respondent for the mark DISAPPEARING, INC. (with a disclaimer of INC.), in standard characters, for "tattoo removal" in International Class 44. On March 12, 2019, Respondent filed a request pursuant to Trademark Act Section 7 to amend the registered mark from DISAPPEARING, INC. to DISAPPEARING INC. by removing the comma.[3] The United States Patent and Trademark Office ("USPTO") granted Respondent's request and issued an updated registration certificate for the mark DISAPPEARING INC. (with the disclaimer of INC.) on May 28, 2019.[4]

In its amended petition to cancel, Petitioner pleads a single claim of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d).[5] In support thereof, Petitioner pleads prior common law rights in the mark DISAPPEARING INK for laser tattoo removal services.[6] Respondent, in its answer, denies the salient allegations in the amended petition to cancel and asserts affirmative defenses

[3] *See* Trademark Status & Document Retrieval database ("TSDR"), March 12, 2019, Section 7 Request.

[4] *See id.* at May 28, 2019, Updated Registration Certificate.

[5] 15 TTABVUE.

[6] *Id.* at 2, ¶¶ 1-3. The Board participated in the parties' August 27, 2020 mandatory discovery conference pursuant to Trademark Rule 2.120(a)(2)(i), 37 C.F.R. § 2.120(a)(2)(i). 19 TTABVUE 1. In connection therewith, the Board determined Petitioner's Section 2(d) claim set forth in its amended petition to cancel was sufficiently pleaded. *Id.* at 2.

contending that Petitioner's claim is time-barred pursuant to 15 U.S.C. § 1064, and barred by the equitable doctrine of laches.[7]

II. Respondent's Motion for Summary Judgment

A. Timeliness

A party may not file a motion for summary judgment until the party has made its initial disclosures, except for a motion asserting claim or issue preclusion, or lack of jurisdiction on the part of the Board. *See* Trademark Rule 2.127(e), 37 C.F.R. § 2.127(e). In its June 4, 2020 order denying Respondent's motion to dismiss, the Board informed the parties that "the materiality of the alteration of the mark will be determinative of the question of whether the claim is time-barred under 15 U.S.C. § 1064, and is thus jurisdictional in nature. In these circumstances, Petitioner may file a motion for summary judgment in this proceeding prior to serving its initial disclosures."[8] Accordingly, we find the motion is timely. *See* Trademark Rule 2.127(e); *cf. Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 217 USPQ 505, 508 (Fed. Cir. 1983) ("Under § 14, a petition to cancel a registration of a mark is precluded after five years, except on limited grounds.").

B. The Parties' Arguments and Evidence

Respondent seeks summary judgment on its affirmative defense that Petitioner's Section 2(d) claim is time-barred, contending that the five-year period for bringing a Section 2(d) claim pursuant 15 U.S.C. § 1064 runs from April 22, 2014—the date its

[7] 16 TTABVUE.

[8] 14 TTABVUE 7, n.6.

original registration for DISAPPEARING, INC. issued—rather than from May 28, 2019—the date its amended registration for DISAPPEARING INC. issued.[9] In support thereof, Respondent argues the 2019 amendment to its registered mark did not materially alter the mark or enlarge its rights therein because the original and amended marks remain legal equivalents which sound the same and convey the same commercial impression.[10] Respondent contends that both the amended mark and the original mark convey a double meaning of "a business entity," and "tattoo ink disappearing."[11] Although Respondent did not submit any evidence with its summary judgment motion, the pleadings and file of the involved registration are automatically of record in this proceeding. *See* Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1); *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1628 (Fed. Cir. 2009).[12]

[9] 18 TTABVUE 2, 4-5, 8-9.

[10] *Id.* at 6-8.

[11] *Id.* at 7.

[12] We note that Respondent states in its brief that "the Board can take judicial notice that nearly every business entity appearing before it includes a term designating the entity's legal character (e.g., Corp., Inc., Ltd.) in its name, whereas there is no uniformity with respect to the presence or absence of an internal comma." 18 TTABVUE 7-8, n.2. Respondent appears to rely on various decisions of the Board issued on August 7 and 14, 2020, for the asserted fact. *Id.* Inasmuch as Respondent did not provide the case citations, proceeding numbers, or copies thereof, we decline to take judicial notice of the referenced entity designations. *See Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co., Inc.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (party requesting judicial notice be taken must provide the necessary information); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 704.12(b) (2021). Moreover, the identification of a party's name in the caption of a proceeding fails to show that the business name identified therein is also used as an identifier of source for that party's goods or services, and accordingly has little, if any, bearing on the issue presented herein.

In response, Petitioner argues that resolution of Respondent's motion requires a determination of whether the original and amended forms of Respondent's mark convey the same commercial impression to the ordinary consumer, which is a mixed question of law and fact.[13] Petitioner contends that by deleting the comma from the mark DISAPPEARING, INC., Respondent removed the visual separation between the words, thereby changing the commercial impression of the mark from that of an incorporated business to that of a double entendre[14] conveying not only a business name, but also ink that disappears, bringing Respondent's mark closer to that of Petitioner.[15] Petitioner points to the examining attorney's requiring a disclaimer of INC. during prosecution of Respondent's underlying application as evidence that the original mark did not convey a unitary double entendre, for which a disclaimer would not have been required.[16] Petitioner also asserts that the amendment "undoubtedly improved Respondent's position with respect to Petitioner and explains why less than two weeks after the amendment to the registration was approved Respondent sent petitioner a cease and desist letter."[17]

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[13] 20 TTABVUE 5.

[14] "A 'double entendre' is a word or expression capable of more than one interpretation. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") § 1213.05(c) (July 2021). "For trademark purposes, a 'double entendre' is an expression that has a double connotation or significance as applied to the goods or services." *Id*.

[15] 20 TTABVUE 3, 6.

[16] *Id*. at 4-5.

[17] *Id*. at 6. In its Answer, Respondent admits that "on September 25, 2019, [Respondent's] counsel delivered a letter to Petitioner's counsel stating regarding Petitioner's infringement of [Respondent's] U.S. Service Mark Reg. No. 4,518,685 and refers to the document for its contents." 16 TTABVUE 3, ¶ 13.

In reply, Respondent argues that the examining attorney's requirement of a disclaimer fails to demonstrate the original mark did not convey a dual meaning, arguing the evaluation of a double entendre for purpose of determining whether a component of a mark is registrable is different than evaluating a double entendre for purposes of determining whether an amendment is material.[18] Respondent further argues the Board may properly decide the issue of whether the marks convey the same commercial impression on summary judgment because the Board serves as "the proverbial ordinary consumer in this proceeding" and the parties agree on the underlying facts, but merely disagree on "how the legal standard should be applied to these undisputed facts."[19]

C. Legal Standard

Summary judgment is an appropriate method of disposing of cases in which there is no genuine dispute with respect to any material fact, thus allowing the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(a). A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute as to

[18] 21 TTABVUE 3. To the extent the parties' arguments address the actions of the examining attorney during prosecution of the application underlying Respondent's involved registration and those of the post-registration unit in granting the post-registration amendment of the involved registration, such determinations made in the ex parte context are not evidence and are not controlling in a inter partes proceeding before the Board. Rather, it is the duty of the Board to determine whether the amendment of the involved registration is a material alternation in light of the facts adduced by the parties during this inter parties proceeding. *Cf. Cont'l Gummi-Werke AG v. Cont'l Seal Corp.,* 222 USPQ 822, 825 (TTAB 1984) ("Action on Section 7 requests (delegated by the Commissioner to post-registration examiners) is taken on the basis of the ex parte record available at the time the request is acted on. To the extent that an amendment to a registration becomes an issue in an inter partes proceeding, a record different from that which was before the post-registration examiner is involved, and the Board's decision is, thus, different from a review of the examiner's decision.").

[19] 21 TTABVUE 7.

a material fact, and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great Am. Music Show Inc.,* 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

Additionally, the evidence of record must be viewed in the light most favorable to the non-moving party, Petitioner in this case, and all justifiable inferences must be drawn from the undisputed facts in favor of the non-moving party. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA,* 23 USPQ2d at 1472. We may not resolve genuine disputes as to material facts and, based thereon, decide the merits of the proceeding. Rather, we may only ascertain whether any material fact is genuinely disputed. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1544; *Meyers v. Brooks Shoe Inc.*, 912 F.2d 1459, 16 USPQ2d 1055, 1056 (Fed. Cir. 1990).

D. Analysis and Order

Ordinarily, a petition to cancel a registered mark asserting a claim of likelihood of confusion under Trademark Act Section 2(d) must be brought within five years following registration. *See* 15 U.S.C. § 1064.[20] However, when a registration on the

[20] The grounds upon which a party may challenge a registration that is more than five years old are limited to genericness, functionality, abandonment, fraud, misrepresentation of

Principal Register is amended in a manner that enlarges the registrant's rights, a petition to cancel the registration filed within five years following the amendment is not limited to the grounds specified Trademark Act §§ 14(3) or 14(5), 15 U.S.C. §§ 1064(3) or 1064(5). *See Stanspec Co. v. Am. Chain & Cable Co.*, 531 F.2d 563, 189 USPQ 420, 423-24 (CCPA 1976) (petition to cancel including a Section 2(d) claim was legally sufficient when brought within five years of Respondent's modification of the registered mark to assert earlier dates of use); *see also* TBMP § 307.02(c)(2) ("When a Principal Register registration has been amended, the registration is subject to attack under Trademark Act § 14, 15 U.S.C. § 1064, to the extent that the amendment of the registration has in any way enlarged registrant's rights, as though the registration had issued on the date of the amendment."). An amendment to a registered mark resulting in a mark that is materially different from that originally registered may represent an enlargement of the rights conferred by the original certificate of registration. *See Cont'l Gummi-Werke AG,* 222 USPQ at 824-25 (claim for cancellation of Opposer's pleaded registration, alleging likelihood of confusion with Applicant's involved mark, was legally sufficient where the proceeding was commenced within five years of the registration's modification.).

The issue of whether an amendment of a mark represents a material alteration thereof is a question of fact. *See In re Light*, 662 Fed. Appx. 929, 61 USPQ2d 1121,

source, and the bars to registration in Trademark Act Sections 2(a)-(c), 15 U.S.C. §§ 1052(a)-(c). *See* 15 U.S.C. §§ 1064.

1123 (Fed. Cir. 2016) (citing *In re Thrifty, Inc.*, 274 F.3d 1349, 1352 (Fed. Cir. 2001)).[21] A material alteration exists if the old and new forms of the registered mark do not create the same general commercial impression.[22] *See Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *15 (TTAB 2020) (citing *Paris Glove of Can., Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1861 (TTAB 2007)). In other words, to avoid a finding of material alteration, the amended mark must create the impression of being essentially the same mark as the original. *See In re Thrifty, Inc.*, 61 USPQ2d at 1124 (citing *In re Hacot-Colombier*, 105 F.3d 616, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997)).

In determining whether a proposed amendment materially alters the mark, we compare the proposed amendment with the mark in its original form. *See* Trademark Rule 2.72(a)(2), 37 C.F.R. § 2.72(a)(2); *see also* TMEP § 1609.02(a) ("In determining whether a proposed amendment is a material alteration of a registered mark, the USPTO will always compare the proposed amendment to the mark *as originally registered*.")(Emphasis in the original). Generally, the addition or removal of punctuation such as a comma will not significantly alter the commercial impression of a mark. *See Peterson*, 2020 USPQ2d 11526, at *16 (citing TMEP § 807.14(c). In the

[21] As the Supreme Court noted in *Hana Fin., Inc. v. Hana Bank*, 574 U.S. 418, 113 USPQ2d 1365, at *4 (2015), however, the issue of whether two marks convey the continuing commercial impression may be decided on summary judgment "if the facts warrant it."

[22] In their briefs, both parties refer to the issue of whether Respondent's original and amended marks are "legal equivalents." Marks are considered "legal equivalents" when they create the same continuing commercial impression such that consumers consider them to be the same mark. *See Hana Bank*, 113 USPQ2d at 1367. Thus, the inquiries as to whether a mark's amendment is a material alteration and whether the amended mark is the legal equivalent of the original mark are essentially the same—we look to whether the old and new forms of the registered mark create the same general commercial impression. *See Jack Wolfskin*, 116 USPQ2d at 1368 n.1.

rare case, punctuation may be incorporated into a mark in such way that the mark's commercial impression is changed by the addition or deletion of the punctuation. *See, e.g., In re Guitar Straps Online LLC*, 103 USPQ2d 1745, 1748 (TTAB 2012) (finding proposed addition of a question mark to the mark GOT STRAPS constitutes a material alteration by changing the commercial impression of the original mark from a declaratory statement to an interrogative phrase); *In re Richards-Wilcox Mfg. Co.*, 181 USPQ 735 (Comm'r Pats. 1974) (proposed change of FYE[R-W]ALL and design to FYER-WALL in block letters denied as a material alteration, in part, because the brackets changed the commercial impression of the mark as the initial letters of applicant's name by no longer emphasizing the "R" and "W"), *overruled on other grounds*, *In re Umax Data Sys., Inc.*, 40 USPQ2d 1539 (Comm'r Pats. 1996).

Here, we find no genuine dispute that the deletion of the comma between the two words of the mark is not a material alteration. That is, we find that this case falls within the majority of instances where the addition or deletion of a punctuation mark does not alter its commercial impression or create a different mark. The amended mark DISAPPEARING INC. is substantially the same mark as the original mark DISAPPEARING, INC. because both marks connote both an incorporated entity called DISAPPEARING and "disappearing ink." *See Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1712 (TTAB 2010) ("the initial term in both marks [MAG-NUM STAR and MAGNUM MAXFIRE] is essentially identical; the hyphen in the Mag Instrument's mark does not distinguish them."); *In re Narada Prods. Inc.*, 57 USPQ2d 1801, 1803 (TTAB 2001) ("Nor are we persuaded that the

absence of an ampersand in applicant's mark [CUBA L.A.] is of any legal consequence"); *Pinocchio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227, 1228 (TTAB 1989) ("the marks are virtually identical, the only difference being the insignificant inclusion of an apostrophe in registrant's 'PINOCCHIO'S' mark.").

We find that there is no genuine dispute of material fact that in the context of the services identified in Respondent's registration, the marks DISAPPEARING, INC. and DISAPPEARING INC. convey the same commercial impression of a business corporation and tattoo ink disappearing. We have considered the facts that a disclaimer was required in both versions of the mark because "INC." is the recognized abbreviation of "Incorporated," and that disclaimers generally are not required with a unitary term, but find those facts are not determinative in comparing the two versions of the mark. *Cf. Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012) ("A disclaimer does not remove the disclaimed portion from the mark for the purposes of comparing marks in a likelihood of confusion determination."). The marks vary in an inconsequential way visually, and are identical in sound, meaning, and overall commercial impression. In sum, the amended mark DISAPPEARING INC. is essentially the same mark as DISAPPEARING, INC.

As to Petitioner's reliance on Respondent's cease-and-desist letter as an indication of Respondent's enlargement of its rights emanating from the amendment, there is no evidence showing that Respondent was aware of Petitioner prior to the amendment. Moreover, the fact that Respondent sent Petitioner a cease-and-desist

letter after the amendment, by itself, does not raise any justifiable inference that must be drawn in Petitioner's favor for purposes of deciding whether the amendment was a material alteration to the mark.

Because we find no material alteration in the amendment, we find no enlargement of rights arising from the acceptance of the amendment, and the period for bringing a likelihood of confusion claim was not extended beyond the statutory five-year period that began to run on April 22, 2014.

Accordingly, Petitioner's likelihood of confusion claim is time-barred, and so Respondent's motion for summary judgment is granted. Judgment is entered in favor of Respondent in the cancellation proceeding, and the **Petition to cancel is dismissed with prejudice**.